



PATENT
P57367

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Carl Conrad MAEDER *et al.*

U.S. Serial No.: 10/522953

Examiner: Douglas A. HESS

International Application No.: PCT/CH03/00522 filed on 30 July 2003

U.S. Filing Date: 9 February 2006

Art Unit: 3651

For: CONVEYOR-TECHNOLOGY DEVICE

PETITION UNDER 37 CFR §1.181

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the Office action mailed 20 December 2007 (Paper No. 20071217), entry and consideration of the following timely filed petition is respectfully requested.

Folio: P57367

Date: 6/20/08

I.D.: REB/kf

STATEMENT OF FACTS

1. On 20 December 2007, the Examiner mailed an Office action (Paper No. 20071217). In Paper No. 20071217 the Examiner required labeling Figure 1 “Prior Art”.
2. Seven (7) copies of Decisions on Petition for the following references previously issued by Group Directors to reverse similar requirements by other Examiners to label drawings “Prior Art”, are enclosed:
 - Paper No. 21 issued on 25 February 1998 for U.S. Application Serial No. 08/447,279 filed on 22 May 1995;
 - Paper No. 15 issued on 2 October 1996 for U.S. Application Serial No. 08/343,939 filed on 17 November 1994; and
 - Paper No. (unknown) issued on 15 December 1999 for U.S. Application Serial No. 08/985,544 filed on 5 December 1997.
 - Paper No. (unknown) issued on 23 October 2006 for U.S. Application Serial No. 10/374,980 filed on 3 March 2003;
 - Paper No. (unknown) issued on 14 February 2005 for U.S. Application Serial No. 10/270,340 filed on 15 October 2002;
 - Paper No. 9 issued on 16 October 2002 for U.S. Application Serial No. 10/057,956 filed on 29 January 2002;
 - Paper No. 9 issued on 20 September 2002 for U.S. Application Serial No. 09/468,827 filed on 22 December 1999;

ARGUMENTS AND/OR REMARKS

In Paper No. 20071217, the Examiner required that Figure 1 be labeled as "Prior Art".

The Examiner states:

"Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated."

Manual of Patent Examining Procedure (MPEP) §608.02(g) states:

"Figures showing the prior art are usually unnecessary and should be cancelled, *Ex parte Elliott*, 1904 C.D. 103, 109 O.G. 1337 (Comm'r Pat. 1904). However, where needed to understand applicant's invention, they may be retained if designated by a legend such as "Prior Art."

If the prior art figure is not labeled, form paragraph 6.36.01 may be used.

Figure [1] should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. (See MPEP §608.02(g)."

Applicants explain that Figure 1 is not "Prior Art".

First, in Paper No. 20071217, the Examiner asserted that "Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated" and cited §608.02(g) of the *Manual Patent Examining Procedure* (MPEP). The term "Prior Art" is defined by statute, not by the MPEP. Specifically, 35 U.S.C. §103(a) and (b) define the term "Prior Art" by reference to the several paragraphs of 35 U.S.C. §102. Nothing in any paragraph of §102, however, states that subject matter "which is *old*" constitutes prior art, as asserted by the Examiner in page 2 of the Office action, Paper No. 20071217. In short, the age of the subject matter does not convert that subject matter into prior art, as the term "prior art" is defined by the law of the United States. Consequently, the Examiner's sole rational for imposing the requirement that Figure 1 be labeled as "Prior Art" is contrary to statute and

improper. The requirement must be therefore be withdrawn.

Second, Figure 1 is not itself believed to constitute “Prior Art” as that term is defined by either 35 U.S.C. §102 or 35 U.S.C. §103. The Examiner has introduced no evidence into the record of this application which would either contradict Applicant’s belief or establish that Figure 1 constituted *prior art*, as that term is defined by statute. As evidenced from the Declaration/Oath, the Applicants are citizens of Switzerland, and, as such, devised Figure 1 in Switzerland in order to illustrate Applicants’ discovery of problems plagued in the art. Therefore, since there is no showing that Figure 1 was known to anyone other than the Applicants *in this country* nor is there a showing that Figure 1 was *patented or published in this country or a foreign country*, then Figure 1 can not be deemed to be “Prior Art” absent evidence to the contrary.

Third, Figure 1 is simply abstract representations of the art prepared by the Applicants in an effort to illustrate Applicants’ discovery of problems plagued in the art in accordance with 37 C.F.R. §1.83(b); this discovery is itself, together with Applicants’ abstraction of the art represented by Figure 1, part of the Applicants’ invention. By identifying deficiencies in the prior art and then addressing those deficiencies, Applicants complete the inventive process. As such, Applicants’ effort to identify deficiencies or other undesirable features in the art, does not constitute “Prior Art” as that term is used under 35 U.S.C. §103, and defined by 35 U.S.C. §§102(a)-(g).

Fourth, Applicant has never made any statement admitting that Figure 1 was “Prior Art”. Nowhere in the specification is Figure 1 described “Prior Art”.

REMEDY REQUESTED

In view of the above, the Examiner is requested to:

- A. Withdraw the requirement to label Figure 1 "Prior Art";
- B. Grant Applicants such other and further relief as justice may require.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert E. Bushnell", is written over a horizontal line.

Robert E. Bushnell
Attorney for Applicants
Reg. No.: 27,774

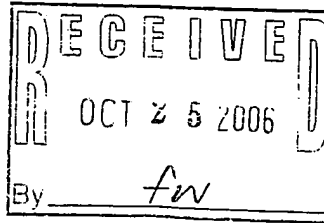
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Folio: P57367
Date: 6/20/08
I.D.: REB/kf



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P56862
(YFM)

Mailed: 10/23/06

Decision on
Petition.

meh

In re application of

Jung-II Nam et al.

Serial No. 10/374,980

Filed: March 3, 2003

For: SECONDARY BATTERY WITH ENHANCED ABILITY TO PREVENT LEAKAGE

DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181, filed September 26, 2006, requesting that the requirement to label Figures 5 and 6 as "Prior Art" be withdrawn.

On September 18, 2006, an office action was mailed by the examiner containing a requirement to label Figures 5 and 6, as Prior Art, since only that which is old is illustrated.

A review of the application indicates that the subject matter in Figures 5 and 6 illustrates a secondary battery and a cap for the battery. However, there is no indication in the disclosure that the subject matter depicted in Figures 5 and 6 is expressly considered by the Applicant to be "Prior Art".

The petition is **GRANTED**.

Accordingly, the requirement that Figures 5 and 6 be labeled as "Prior Art" is withdrawn. It is noted that Applicant's time for response to the September 18, 2006 office action continues to run as set forth in the office action.

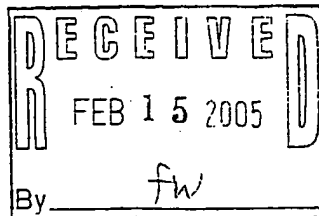
Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Robert E. Bushnell
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Washington, DC 20005



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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

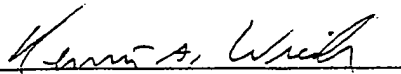
In re Application of:
Kyung-Hwa Min
Application Serial No.: 10/270,340
Filed: October 15, 2002
For: **METHOD FOR TESTING SUBSCRIBER
LINE OF PRIVATE AUTOMATIC BRANCH
EXCHANGE USING DUAL-TONE MULTI-
FREQUENCY SIGNAL**

DECISION
ON PETITION

This is a decision on the petition, under 37 C.F.R. §1.181, filed on December 2, 2004 requesting the withdrawal of the requirement to label Figure 1 as "Prior Art".

The petition is GRANTED.

A review of the record indicates that Figure 1 as originally filed and discussed was referred to as containing a "conventional" line tester in a subscriber circuit. The original disclosure did not indicate that the figure was prior art. Hence, in keeping with the disclosure and applicant's arguments, the requirement to label this figure as "Prior Art" is withdrawn.


for

Mark R. Powell
Technology Center 2600
Communications



COPY

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Paper No. 9

ROBERT E. BUSHNELL
1522 K STREET NW
SUITE 300
WASHINGTON, DC 20005

OCT 18 2002

OCT 16 2002

In re Application of
Chang-Hum Lee
Application No. 10/057,956
Filed: January 29, 2002
For: DEVICE AND METHOD FOR DISPLAYING
CHARGE CAPACITY INFORMATION OF SMART
BATTERY

DECISION ON PETITION


This is a decision on the petition under 37 CFR 1.181, filed on August 22, 2002, requesting that the requirement to label Figures 1 and 2 as "Prior Art" be withdrawn.

The petition is GRANTED.

A review of the application indicates that the subject matter of Figures 1 and 2 illustrates a process for displaying residual capacity information of a general smart battery. However, there is no indication in the disclosure that the subject matter depicted in Figures 1 and 2 is expressly considered by the Applicant to be "Prior Art."

Accordingly, the requirement that Figures 1 and 2 be labeled "Prior Art" is withdrawn.

The application file is being forwarded to Publications for further processing.


Richard Seidel, Director
Technology Center 2800
Power Generation and Distribution, Music,
Electrical Components and Control Circuits



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Paper No. 9

Robert E Bushnell
1522 K Street NW
Suite 300
Washington DC 20005

SEP 23 2002

MAIL

SEP 20 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
HYUNG-GON LEE
Application No. 09/468,827
Filed: December 22, 1999
For: VOICE CODING CONVERSION
CIRCUIT BETWEEN OFFICE EXCHANGE
AND ISDN KEYPHONE SYSTEM

DECISION ON PETITION

COPY

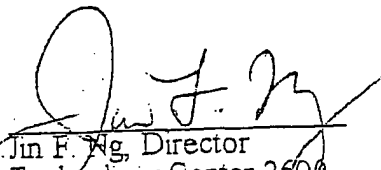
This is a decision on the petition filed June 11, 2002 under 37 CFR 1.181 of the requirement of the Examiner to label Applicant's Figure 1 as "prior art".

On June 3, 2002, a non-final Office action was issued requiring Figure 1 of the drawings to be labeled as "prior art".

A review of the application disclosure shows that applicant describes the subject matter of Figure 1 in conventional terms. There is no indication in the disclosure that the subject matter of the figure is expressly considered by the application to be "prior art". Therefore, the Examiner's requirement that Figure 1 should be labeled as "prior art" is incorrect and will be withdrawn in the next Office Action.

Accordingly, the petition is **GRANTED**.

The application file will be forwarded to the Examiner to await a response from the applicant on the remaining outstanding issues as set forth in the Office Action mailed on June 3, 2002.


Jin F. Ng, Director
Technology Center 2600
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(703) 305-4800

Mailed

FEB 25 1998

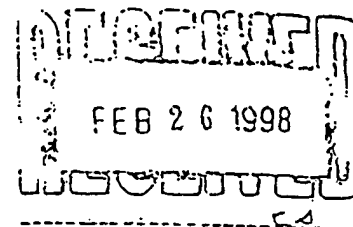
Director's Office
Group 2700



Robert E. Bushnell
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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
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Washington, D.C. 20231

Paper No. 21



In re Application of)
Gwon-Il Kim)
Application Serial No.)
08/447,279)
Filed: May 22, 1995)
For: SERVO CONTROLLER)
APPARATUS AND METHOD)
OF DISK RECORDING)
SYSTEM)

DECISION ON RENEWED
PETITION UNDER
37 C.F.R. § 1.181

This is a decision on the renewed petition filed August 25, 1997 under 37 C.F.R. § 1.181 of the repeated requirement of the Examiner to label Applicant's Figures one through three as "prior art". The petition is treated as a request for reconsideration of the previous decision of August 19, 1997 in which the requirement of labeling figures one through three as "prior art" was maintained.

A careful review of the application papers indicates that the subject matter of figures one through three is considered by applicant to be "conventional". However, there is no indication in the disclosure that the subject matter of the figures is expressly considered by the applicant to be "prior art". "When applicant states that something is prior art, it is taken as being available as prior art against the claims. Admitted prior art can be used in obviousness rejections. In re Nomiya, 184 USPQ 607, 610 (CCPA 1975) (Figures in the application labeled "prior art" held to be an admission that what was pictured was prior art relative to applicant's invention.)" See M.P.E.P. § 2129. The decision, supra, was cited by both petitioner and the deciding official in the previous petition. Whether the subject matter of figures one through three of the instant application is prior art against the claims is an appealable determination and, accordingly, will not be entertained in this decision, see M.P.E.P. § 1201.

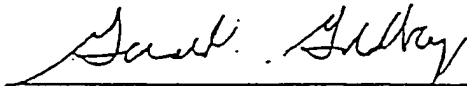
There is no requirement that a particular figure or figures be labeled as "prior art". The MPEP at section 608.02(g) indicates that if prior art figures are to be retained in the file they

should be designated with the legend of "prior art". No requirement is made for an applicant to label figure(s) as "prior art" where there is no such indication in the disclosure.

Consequently, the requirement that figures one through three each be designated by the legend of "prior art" is withdrawn.

As the time for perfecting the appeal under 37 C.F.R. § 1.192(a) has expired without the submission of an Appeal Brief, the appeal is hereby dismissed, 37 C.F.R. § 1.192(b). The application file will be forwarded to the examiner for appropriate action in due course.

SUMMARY: Petition GRANTED.

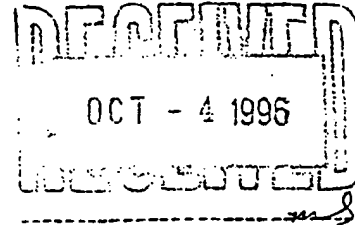


Gerald Goldberg, Director
Technology Center 2700-
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#15

In re Application of
MYUNG-CHAN JEONG
Serial No: 08/343,939
Filed on : November 17, 1994
For : DIGITAL SERVO CONTROL
APPARATUS AND METHOD
OF DATA STORAGE SYSTEM
USING DISK RECORDING
MEDIA

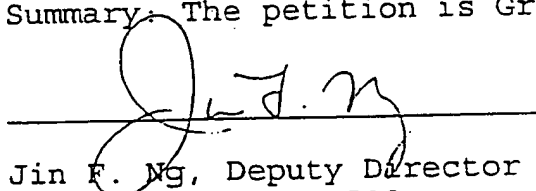
DECISION ON PETITION
UNDER 37 CFR 1.181

This is a decision on the petition filed on September 13, 1996
requesting the withdrawal of the requirement to label Fig. 3 as
"Prior Art".

The petition is GRANTED.

A review of the record indicates that figure 3 as originally
filed and discussed was referred to as "CONVENTIONAL". Hence, in
keeping with the disclosure and petitioner's arguments, the
examiners' requirement to label this figure as "Prior Art" is
incorrect and withdrawn.

Summary: The petition is Granted.


Jin F. Ng, Deputy Director
Examining Group 2500
Electrical and Optical Systems
and Devices

JFN/AMP

Robert E. Bushnell
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MAILED

OCT 2 - 1996

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GROUP 2500

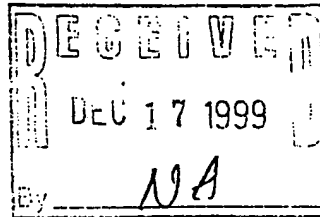
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Group 3600



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Washington, D.C. 20231



ROBERT E BUSHNELL
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1522 K STREET, N.W., SUITE 300
WASHINGTON, D.C. 20005-1202

In re application of
Hae-Won Ahn
Serial No.: 08/985,544
Filed : December 5, 1997
For: FRONT CASE STRUCTURE OF CRT
DISPLAY DEVICE

PS4947

: DECISION ON PETITION
: UNDER 37 CFR §1.181
: REQUESTING THAT
: THE COMMISSIONER
: INVOKE SUPERVISORY
: AUTHORITY

In the renewed petition filed September 9, 1999, applicant requested that the Commissioner invoke supervisory authority by instructing the examiner to withdraw the requirement that Figs. 1 and 2 be labeled as "Prior Art". The petition is GRANTED.

This petition presents two issues. First, are the figures in question necessary to the understanding of the invention? A review of the application has been made and it is considered that the figures are necessary to the understanding of the invention. Second, are the figures required to be labeled with the legend "Prior Art"?

A careful review of the application papers indicates that the subject matter of Figures 1 and 2 are considered by applicant to be "conventional". However, there is no indication in the disclosure that the subject matter of the figures is expressly considered by the applicant to be "Prior Art". If applicant states that something is prior art, it is available for use against the claims. See *In re Nomiya*, 184 USPQ 607 (CCPA 1975), MPEP §2129. No opinion is expressed in this decision whether the subject matter of Figures 1 and 2 are "Prior Art" since this is an appealable issue, MPEP §1201.

Finally, any concerns raised in the previous decision regarding applicant's duty of disclosure are withdrawn. The Office does not normally investigate such issues.
1135 Off. Gaz. Pat. Office, 13 (Jan. 9, 1992).

This application is being forwarded to the examiner for reinstatement of Figs. 1 and 2 and deletion of the amendment after final filed August 4, 1999.

Al Lawrence Smith, Director
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AK

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